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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/303,062 | 04/30/1999 | ANURAG MENDHEKAR | OLAI-1005-MC | 7841 |

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT PAPER NUMBER

2152

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/303,062

Applicant(s)

MENDHEKAR ET AL.

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all features in claims 1-4 must be shown in the drawings or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There does not appear to be a written description of the limitation “identifying a section in the contents based on a preference of a user; and reformatting the identified section to generate a new rendition, depending on a character of the specific class of devices and a preference of the user; such that the new rendition can be displayed on the specific class of device” in claims 1 and 3 and “the user is selected from the group of an end-user viewing the new rendition and the provider of the set of contents.”

The claims' language in claims 1-4 are not appropriate because it is not clear that what the applicant intend to claim, e.g., identifying section of content, reformat the identified section. Further, it is not clear that the user is selected from the content or from the provide. The claim language as written could by broadly read on several means and function including read on hotspot, hyperlink on a web page as being applied below. It is

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suggested that is an applicant's duty to present a clear and concise claim's language for examination.

4. Claims 2 and 4 recites the limitation "the user" in claims 2 line 1 and claim 4 line 1.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Rangan et al (UIS. 6,154,771).

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7. Claim 1 and 3, Rangan discloses the invention substantially, as claimed, including a computer-aided method and apparatus to selectively display a pre-determined set of contents for a specific class of devices, comprises:

generating an image of a pre-determined rendition of the set of contents;

identifying a section in the contents based on a preference of a user; and

reformatting the identified section to generate a new rendition, depending on a character of the specific class of devices and a preference of the user;

such that the new rendition can be displayed on the specific class of device.

Rangan discloses a method, apparatus and computer program (system) for interactive subscriber/user/view (SUV), which capable of generating and providing web page, e.g., image, for rendering specific contents to user(s), e.g., generating an image of a pre-determined rendition of the set contents (fig 5-7, Col. 24, lines 6-37; Col. 26, lines 47-63).

Further, Rangan discloses the system allow user to select (user selecting is a user preference) and activate hot spot, e.g., identifying a section in the contents based on a preference (fig 5-7, Col. 24, lines 6-37; Col. 26, lines 47-63);

Furthermore, Rangan discloses upon click in on hotspot the system provides new contents associated to the hot spot. At least three classes of device is disclosed, figure 6 illustrates rendering a web page, figure 7 illustrates rendering video, figure 8, illustrates rendering slide show, which teaches reformatting the identified section, generate and display a new rendition depend on device class preference of the user such that the new

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rendition can be displayed on the specific class of device (fig 5-7, Col. 24, lines 6-37; Col. 26, lines 47-63).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rangan, as applied to claims 1 and 3 and further in view of Tognazzini et al. (US. 5,731,805).
10. Claims 2 and 4, Rangan does not express selecting the user from the group of an end-user viewing the new rendition and the provider of the set of contents.

However, selecting a user from group or users to view a content based on the type of content was well known in the art, such technique was known as targeting information, which allow content provider to narrowly transmits certain type of web content to a specific user(s), as has been taught by Tognazzini (Col. 16, lines 29-45).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate targeting information technique as taught by Tognazzini to selecting a user to receive content in Rangan's system. Because selecting user for receiving specific information using less transmission bandwidth, therefore, m reducing transmission cost. Furthermore, it would eliminate browsing noise, thereby increasing user convenient and reducing end-user's cost.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is 703-305-9673. The examiner can normally be reached on 6:45-17:15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5480 for regular communications and 703-746-7238 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Bunjob Jaroenchonwanit
Examiner
Art Unit 2152

bj
September 13, 2002